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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/530,734  | 04/08/2005  | Kouichi Satou        | 270307US2PCT        | 2086             |
| 22850   | 7590        | 01/13/2006           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | KARIKARI, KWASI     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2686                |                  |

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/530,734

Applicant(s)

SATOU, KOUICHI

Examiner

Kwasi Karikari

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1 is rejected under 35 U.S.C. 102(b) as being unpatentable over Walker et al. (U.K. Application No. 9505549.7) (hereinafter Walker).**

Regarding claim 1, Walker discloses a mobile communication terminal (M, see Fig. 1) which can be made to communicate with a base station (BS1,2 or 3, see Fig. 1) when being connected with an IC card (Page 4, lines 4-10 and Fig. 2) that stores an identification number (IMSI, see Page 6, lines 18-20) peculiarly assigned thereto and a subscriber's personal information (see item 10 in Fig. 2 and Page 6, line 15-18), characterized in that said mobile communication terminal comprises:

a storage unit for storing identification numbers of IC cards (storage location 48 in the memory 12 stores the first five digits of the IMSIs of a particular network whose service providers are to have SP-Personalization feature, see Page 8, lines 2-16 and Fig. 3); and

an identification processing unit (identification process involves the SIM Reader 16 and Comparing units 22 and 52, see Page 9, line 16- Page 10, line 13 and Fig. 3) for determining whether or not an identification number of an IC card connected to said

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mobile communication terminal is stored in said storage unit, and for determining whether said mobile communication terminal is being fraudulently used when the identification number of the IC card connected to said mobile communication terminal is not stored in said storage unit (Card reader reads the IMSI and unit 22 compares and determines whether the IMSI in the SIM card is correct, see Page 10, line 13- Page 11, line 9 and Page 12, line 18- Page 13, line 7).

Regarding **claim 4**, Walker discloses a mobile communication terminal (M, see Fig. 1) which communicate with a base station (BS1,2 or 3, see Fig. 1) when being connected with an IC card (Page 4, lines 4-10 and Fig. 2) that stores an identification number (IMSI, see Page 6, lines 18-20) peculiarly assigned thereto and a subscriber's personal information (see item 10 in Fig. 2 and Page 6, line 15-18), characterized in that said mobile communication terminal comprises:

a storage unit for storing identification numbers of IC cards and subscribers' personal information (storage location 48 in the memory 12 stores the first five digits of the IMSIs of a particular network whose service providers are to have SP-Personalization feature, see Page 8, lines 2-16 and Fig. 3); and

an identification processing unit (identification process involves the SIM Reader 16 and Comparing units 22 and 52, see Page 9, line 16- Page 10, line 13 and Fig. 3) for disabling information (incorrect IMSI causes handset to enter into fail/blocked state, see Page 10, lines 8-13) except a subscriber's personal information corresponding to an identification number which is stored in said storage unit and is also stored in an IC card

connected to said mobile communication terminal (Card reader reads the IMSI and unit 22 compares and determines whether the IMSI in the SIM card is correct, see Page 10, lines 13- Page 11, line 9 and Page 12, lines 18- Page 13, line 7). .

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claim 2 is rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Miller et al., (U.S. 6,141,563), (hereinafter Miller).**

Regarding **claim 2**, as recited in claim 1, Walker fails to teach a request for input of a password peculiar to the mobile communication terminal, and, when accepting a wrong password, disables the mobile communication terminal.

Miller teachings of a valid password been required for further operation of the mobile device; and an invalid entry of password renders the device functionless (see col. 5, lines 8-18), meets the claimed limitation of requesting an input of a password peculiar to the mobile communication terminal, and, when accepting a wrong password, disables the mobile communication terminal.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teachings of Miller into the system of Walker for the benefit of achieving a system that uses an input password for authenticating subscriber's unit.

**3. Claim 2 is rejected under U.S.C. 103(a) as being unpatentable over Walker in view of Rao et al., (U.S. 20040076128 A1), (hereinafter Rao).**

Regarding **claim 3**, as recited in claim 1, Walker fails to teach that both the identification number of the IC card connected to the mobile communication terminal, and an ID peculiar to the mobile communication terminal are transmitted to the base station so as to make a request of the base station to perform authentication of the IC card, and, when receiving a result indicating that the IC card is an unauthorized one from the base station, disables said mobile communication terminal

Rao teaching of the PIN and IMSI of the mobile device been sent to the an authentication server for authenticating process; and notifying the user of the device about a denied access, if authentication fails (see Pars. [0024-25]), meets the claimed limitation of claim 3.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teachings of Rao into the system of Walker for the benefit of achieving a system that includes an authentication server in the communication system.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Sasakura et al. (U.S. 6,151,493)** teaches a device for prohibiting unauthorized use of electronic device.

**Grube et al. (U.S. 5,638,423)** teaches method of detecting use of a stolen communication unit.


**Schroderus et al., (U.S. 5,907,804)** teaches checking the identification number of a mobile subscriber.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571- 272 5905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwasi Karikari  
Patent Examiner.



**CHARLES APPIAH**  
**PRIMARY EXAMINER**